

REMARKS

Claims 1-12 are pending in the present application.

This Amendment is in response to the Office Action mailed September 24, 2008. In the Office Action, the Examiner objected to claim 6, rejected claims 1, 2 and 7-10 under 35 U.S.C. § 102 and claims 3-5 under 35 U.S.C. § 103(a).

Applicant has amended claims 1-10 and added claims 11 and 12. In addition, the Examiner indicated allowable subject matter for claim 6 if it is rewritten in independent form including the base claim and any intervening claims.

Reconsideration in light of the amendments and remarks made herein is respectfully requested.

I. REJECTION UNDER 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 1, 2 and 7-10 under 35 U.S.C. § 102(b) as being anticipated by Miyata et al. (JP 2000207738). Applicant respectfully traverses the rejections for the following reasons.

Miyata et al. discloses controlling the timing of an electron irradiation using formed exposure position reference marks 21 formed on the base material 11. Miyata et al., however, does not disclose controlling the electron irradiation based on rotation angle, shift position, and recording data as recited in independent claims 1 and 10, as amended.

To support a 102 rejection, the Examiner must show that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bro. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987), (MPEP §2131). In addition, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989), (MPEP §2131). Since Miyata et al. fails to disclose at least one claimed element as discussed, independent claims 1 and 10, as well as the claims that depend therefrom, are patentable over Miyata et al.

Since there is no showing of the identical invention in as complete detail as is contained in the claim, Applicant respectfully requests that rejection under 35 U.S.C. §102(b) be withdrawn.

New claims 11 and 12 are also patentable over Miyata et al. for the reasons stated.

II. REJECTION UNDER 35 U.S.C. § 103

The Examiner rejected claims 3-5 under 35 U.S.C. § 103(a) as being unpatentable over Miyata et al. and further in view of Hiyasuki et al. Applicant respectfully traverses the rejections for the following reasons.

Hiyasuki et al. does not disclose controlling the electron irradiation based on rotation angle, shift position, and recording data as recited in independent claims 1 and 10, as amended. Therefore, since Miyata et al. fails to disclose the Applicant's claimed invention for the reasons stated above, it follows then that the combination of Miyata et al. and Hiyasuki et al. also fails to disclose the Applicant's invention as recited in the independent claims. Moreover, neither Miyata et al. nor Hiyasuki et al., taken alone or in any combination, suggest, or render obvious the combination as recited in the Applicant's pending claims.

Therefore, since independent claims 1 and 10 are distinguishable over the cited prior art references, dependent claims 3-5 are also distinguishable therefrom. Accordingly, Applicant respectfully requests the rejection under 35 U.S.C. § 103(a) be withdrawn.

New claims 11 and 12 are also patentable over the combination of Miyata et al. and Hiyasuki et al. for the reasons stated.

III. COPENDING U.S. APPLICATIONS

In complying with the duty of disclosure set forth in 37 CFR 1.56, Applicant wishes to inform the Examiner that copending U.S. Application Nos. 10/679,416,

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USSN: 10/594,056

PATENT
Art Unit: 2627

10/658,271, 10/593,476, 10/591,750, 10/593,744, 11/587,932 is directed to subject material related to that disclosed in this Application.

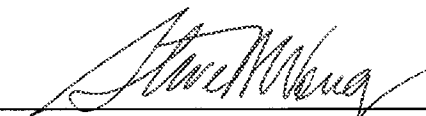
CONCLUSION

In view of the amendments and remarks made above, it is respectfully submitted that the pending claims are in condition for allowance, and such action is respectfully solicited. If it is believed that a telephone conversation would expedite the prosecution of the present application, or clarify matters with regard to its allowance, the Examiner is invited to contact the undersigned attorney at the number listed below.

The Commissioner is hereby authorized to charge payment of any required fees associated with this Communication or credit any overpayment to Deposit Account No. 04-1175.

Respectfully submitted,
PIONEER NORTH AMERICA, INC.

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